

REMARKS

1. Claims 1-22 are pending in the Application, and Claims 1 and 12 have been amended to clarify the claim term "multi-axis". The Examiner has rejected Claims 1-5, 7-16, and 8-22. The Examiner has found allowable subject matter in Claim 6 and 17, provided they are rewritten to include all the limitations of the base claim and intervening claims from which they depend. The Examiner is thanked for finding allowable subject matter in Claims 6 and 17.

2. Applicants object to the finality of the Office Action mailed on June 18, 2003. The final rejection was the first Office Action in response to a Request for Continued Examination (RCE) under 37 C.F.R. 1.114. The RCE included an amendment to Claims 11 and 22, and thus all claims in the RCE were not drawn to the same invention claimed in the application prior to submission of the RCE. Accordingly, the finality is improper and should be withdrawn.

3. The Examiner is thanked for his courtesy for a telephonic interview that was held on July 15, 2003, with the undersigned attorney. During the interview, Claims 1 and 12 were the primary objects of discussion, along with the claim term "multi-axis digital measuring device." The undersigned advanced the point of view that this term requires at least two axes of motion, as the term "multi-axis" is defined in the specification, while the references showed no axes of motion. The Examiner stated that perhaps the requirement for axes of motion should be included in the claims, but that this might require further searching.

4. In accordance with the Examiner's summary of the interview with the undersigned attorney on July 15, 2003, Applicants have amended the independent claims of the present application to clarify the meaning of the claim term "multi-axis." Independent Claims 1 and 12 as filed claim a method for repair that uses a "multi-axis digital measuring device." The specification defines a "multi-axis" measuring machine as one "having linear axes or rotary axes of motion." Specification, p. 3, lines 6-7. The specification also states that the "measuring device may be a multi-axis coordinate measuring machine 40, having a base 42 and at least one linear axis 44, and preferably having at least one rotary axis 46." Specification, p. 5, lines 10-12. In addition, common meanings of "multi" include "more than one." Merriam-Webster's Collegiate Dictionary, 10th ed. at 764.

One of the privileges of applicants for a patent is that they may be their own lexicographers. So long as the meaning of an expression is made reasonably clear and its use is consistent within a patent disclosure, an inventor is permitted to define the terms of his claims; the place to do so is in the specification of the inventor's application, and the time to do so is prior to that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 USPQ 1025, 1031 (Fed. Cir. 1984)

In this application, Applicants have defined in the specification a multi axis digital measuring device as one having two or more linear or rotary axes of motion. Therefore, amending claims to state that a multi-axis digital measuring device is one “having at least two axes of motion” does not narrow the claims in the sense of *Festo*. Accordingly, the amendments of Claims 1 and 12 are not narrowing amendments as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 62 U.S.P.Q.2d 1705 (2002).

5. The Examiner has rejected Claims 1-5, 7, 9, 10, 12-16, 18, 20 and 21 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,913,555 to Karl-Hermann Richter et al. (“Richter”). As to Claims 1 and 12, the Examiner states that Richter discloses a method for repairing a structure wherein a multi-axis digital measuring device is oriented and then used to capture an image “in at least two dimensions” in order to repair a sheet metal repair part. Office Action, p. 2, lines 16-19. Applicants traverse the rejection. Richter discloses only a camera (10) and an image-processing computer (11). Richter further states that the camera is used only at a standardized “height h and provides data thereto to an image processing computer 11.” Richter, col. 4, lines 46-48. This is a process for a two-dimensional image, not a three-dimensional image. Richter further states, “the cutting of the sheet or plate for making the repair profile is carried out using a two-dimensional cutting guidance with a cut angle that is maintained 90° relative to the local surface of the sheet or plate.” Col. 2, line 64 to col. 3, line 1.

The Examiner states that “the digital camera clearly functions as a multi-axis digital measuring device and in addition the height and depth of the remaining blade portion is captured and measured by the digital camera.” Office action, p. 5, last two lines, to page 6, lines 1-2. The Examiner cites to Richter, col. 4, lines 38-59 for further clarification. This passage recites

the existing actual geometry of the end of the remaining blade portion 2 at the standardized height h is measured, preferably by means of an image processing technique, by which the actual geometry is numerically detected and analyzed . . . a camera, such as a digital camera 10 captures the image of the end of the remaining blade portion 2 at the height h and provides data corresponding thereto to an image processing computer 11.

Col. 4, lines 38-48.

Other passages in Richter also recite the “height h” limitation, and even the claims recite “measuring an actual geometry of an end of said remaining blade portion at said standardized height.” Claim 1 of Richter, col. 6, lines 50-51. Thus, Richter is limited to providing a camera image in a single, two-dimensional plane at height h, as explained in the cited passage.

A camera is not a multi-axis digital measuring device, as claimed in Claims 1 and 12, and as defined in the specification of the present application. The specification states, on page three, lines 6-7, that the claimed device is a “multi-axis measuring machine, having linear or rotary axes of motion.” Richter discloses no camera with any axis of motion, such as a linear or rotary axis of motion. The only camera shown in the drawings, designated by numeral 10 in Fig. 5 of Richter, appears to be an ordinary camera for acquiring and processing an optical image. *See* col. 4, lines 45-49. Richter does not anticipate the claimed invention, which expressly includes a multi-axis digital measuring device. An invention is not anticipated when the same device or method, including all the limitations contained in the claims, is not described in a single prior art reference. *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. Appl. & Int. 1990). Therefore, the Examiner is requested to withdraw the rejection of Claims 1 and 12 under 35 U.S.C. §102(b).

The remaining rejections under 35 U.S.C. § 102(b) for Claims 2-5, 7, 9, 13-16, 18, 20 and 21 are moot in light of Richter’s failure to disclose a multi-axis digital measuring device. Applicants submit that the rejection under 35 U.S.C. § 102(b) is overcome and respectfully request the Examiner to withdraw the rejections under 35 U.S.C. §102. As discussed above, Claims 1 and 12 have been amended in a non-narrowing manner in order to expedite prosecution of the application.

6. The Examiner has rejected Claims 8, 11, 19 and 22 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 5,913,555 to Karl-Hermann Richter et al. (“Richter”) in view of U.S. Pat. No. 5,736,201 to Mary Linda Flint (“Flint”). The rejection states that Richter discloses all the claimed subject matter except for transferring the repair part from a first workstation to a second workstation, or mounting a laser-scanning device. The Examiner states that Flint discloses transferring an unfinished part from a first workstation to a second workstation in order to build a duplicate part, and that it would have been obvious to transfer an unfinished repair part from Richter to a second workstation according to Flint.

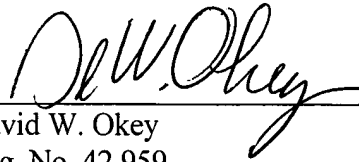
Applicant traverses the rejection, on the grounds that there is no suggestion to combine the references, and that therefore the Examiner has failed to make a prima facie case of obviousness. In addition, the combination of the improperly-combined references still does not describe or suggest all the limitations of the method claimed in Claims 8, 11, 19 and 22 of the present application.

As a motivation for combining the references, the Examiner states that “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Office Action, p. 6, lines 12-17. The Examiner then states what the Examiner believes Richter and Flint disclose, and states that it would have been obvious to one of ordinary skill in the art to manufacture the part of Richter according to the teaching of Flint, thereby rendering Applicants’ claimed invention obvious. Office Action, p. 7, lines 1-4. The Examiner has not stated any motivation for combining the references, and therefore has failed to make a prima facie case of obviousness. M.P.E.P. 2143.

Even if the references are combined, neither reference describes or suggest a multi-axis digital measuring device. As discussed above, Richter discloses only a digital camera. Flint discloses a video camera and a laser scanner, but neither have an axis of motion, since Flint depends on rotating a live person, not moving a multi-axis measuring device. Even the improperly-combined references do not describe or suggest all the limitations of the claimed inventions. Accordingly, the Examiner is respectfully requested to withdraw the rejections of Claims 8, 11, 19 and 22.

7. Applicants have amended Claims 1 and 12 in accordance with Examiner's request to better define the claim terms. The amendments are not narrowing amendments in the sense of *Festo* because the amendments merely include in the claims a definition of a claim term that had previously been made explicit in the specification. Applicants believe that the Claims are in form for allowance, and respectfully request the Examiner to allow Claims 1-22. If the Examiner does not believe that the claims are in form for allowance and that a new search is required, the Examiner is requested to withdraw the finality of the present Office Action.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "D. W. Okey", written over a horizontal line.

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